

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN R. LAINE
JOHN A. RUDESILL and WU-CHENG CHENG

Appeal No. 1996-3457
Application 08/200,595¹

ON BRIEF

Before JOHN D. SMITH, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 5 as amended subsequent to the final rejection, which are all of the claims in the

¹ Application for patent filed February 23, 1994. According to appellants, this application is a division of application 07/827,119, filed January 28, 1992, now United States Patent 5,304,526, issued April 19, 1994, which application is a division of application 07/780,680, filed October 18, 1991, now United States Patent 5,147,836, issued September 15, 1992.

application.²

We have carefully considered the record before us, and based thereon, find that we cannot sustain the sole ground of rejection advanced on appeal: claims 12 through 15 and 17 are rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure (answer, pages 3-5). It is well settled that under § 112, first paragraph, the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification are in doubt, including reasons why the description of the invention in the specification would not have enabled one of ordinary skill in *this* art to practice the claimed invention without undue experimentation, in order to establish a *prima facie* case under the enablement requirement of the first paragraph of § 112. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). It is further well settled that “[a]n inventor need not . . . explain every detail [of the invention] since he is speaking to those skilled in the art. What is conventional knowledge will be read into the disclosure. Accordingly, an applicant’s duty to tell all that is necessary to make or use varies greatly *depending upon the art to which the invention pertains*” (emphasis supplied). *In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981). However, if appellants choose “to rely upon general knowledge in the art to render [their] disclosure enabling, then the burden rests upon [them] to establish that those of *ordinary* skill in the art can be expected to possess or know where to obtain this knowledge.” *Howarth*, 654 F.2d at 107, 210 USPQ at 693.

The examiner has taken the position that the specification “does not contain any description of the cracking process” and “fails to provide even minimal process steps and conditions” (answer, page 3). Appellants rely, *inter alia*, on the disclosure in their specification that bayerite and eta alumina are used in catalysts for hydrocarbon cracking processes, citing EP 0 385 246, and other exemplification

² See the amendments of July 14, 1995 (Paper No. 13), March 9, 1995 (Paper No. 9) and October 24, 1994 (Paper No. 6).

pertaining to hydrocarbon cracking in certain specification Examples, in submitting that “the general knowledge in the prior art regarding cracking processes is such that when taken with the albeit limited discussion in appellants’ disclosure, it would enable one of ordinary skill in the art to practice the invention without undue experimentation” (brief, page 3). Appellants further contend that from this disclosure, “it is apparent that the catalysts [of the claimed compositions] are useful in catalytic cracking processes” (*id.*, pages 3-4). In response, the examiner alleges that “the catalyst composition utilized in EP 0 385 246 is not the same as that utilized in the claimed invention” and that the specification Examples do “not indicate or disclose any process conditions or parameters” (answer, pages 4-5).

We must agree with appellants. Indeed, it is clear from the disclosure that appellants rely on the citation of EP 0 385 246 to establish that “fluid catalytic cracking (FCC) catalysts that contain a bayerite/eta alumina component” are known and that appellants further disclose that certain problems are presented when such fluid catalytic cracking catalysts are used “in *commercial* FCC cracking units,” which are the problems addressed by appellants through the disclosed and claimed invention (specification, pages 2-3, emphasis supplied; see also pages 5-6 and specification Examples 5-7). Thus, in order to make out a *prima facie* case under this section of the statute, the examiner must show that one of ordinary skill *in the hydrocarbon cracking arts* could not practice the claimed invention based on the information supplied in appellants’ disclosure without undue experimentation, which requires more evidence than merely pointing out that specific “process conditions or parameters” have not been disclosed.

The examiner’s decision is reversed.

Reversed

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| JOHN D. SMITH |) | |
| Administrative Patent Judge |) | |
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| CHARLES F. WARREN |) | BOARD OF PATENT |

Appeal No. 1996-3457
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Administrative Patent Judge

-) APPEALS AND
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